

REMARKS

The present application includes pending claims 1-23, all of which were rejected. In particular, despite being reversed by the Board of Patent Appeals and Interferences (the "Board"), claims 1, 4, and 6 remain rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 5,339,799 ("Kami"), while claims 2, 3, 5, and 7-23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kami. The Applicant respectfully traverses these rejections for at least the following reasons.

Claim 1 recites, in part, "a strain gauge affixed to an outer portion of said flexible engaging member, wherein said strain gauge detects movement of said operative distal tip of said flexible engaging member." Kami does not describe, teach, or suggest these limitations, as previously explained **and as confirmed by the Board**. See November 5, 2010 Decision on Appeal. Indeed, Kami does not anticipate or render any of the claims unpatentable for at least the reasons set forth in the Appeal Brief, the Reply Brief, and the **Decision on Appeal**.

Indeed, the rejections noted above are the exact same rejections that the Board considered. See November 5, 2010 Decision on Appeal at page 2. The Board considered these rejections **and reversed the Examiner in full**. See *id*. Accordingly, the present application should proceed towards allowance and issuance.

The Manual of Patent Examining Procedure (MPEP) is clear with respect to a complete reversal of the Examiner, such as in the present application:

A **complete reversal** of the examiner's rejection brings the case up for **immediate action by the examiner**. If the reversal does not place an application in condition for immediate allowance (e.g., the Board has entered a new ground of rejection under 37 CFR 41.50(b)), the examiner should refer to the situations outline in MPEP § 1214.06 for appropriate guidance.

See MPEP § 1214.04 (emphasis added).

In this case, the complete reversal of the Examiner's rejections by the Board did, in fact, place the application "in condition for immediate allowance," in that, the Board did not enter a new ground of rejection, nor suggest in any way that the application should not be placed in condition for allowance.

Additionally, the "examiner should **never** regard such a reversal as a challenge to make a new search to uncover other and better references." See *id.* (emphasis added). It stands to reason that if the examiner should never regard such a reversal as a challenge to uncover other references, the examiner should also not attempt to assert the exact same rejections that the Board reversed. By attempting to do so now, the Examiner has not given the Board decision "full faith and credit." In short, **the Examiner cannot disregard a decision of the Board.**

For at least these reasons, the Applicant respectfully submits that the application should be placed "**in condition for immediate allowance,**" as mandated by the MPEP.

If the application is **not** placed in condition for immediate allowance (or if the Examiner attempts to assert any new ground of rejection), before doing so, the Applicant respectfully requests an interview with the Examiner, the Examiner's supervisor, and the art unit Director to understand why a Board decision is seemingly being ignored, and proper examining procedure is being disregarded.

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. The Applicant expressly reserves the right, however, to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited to contact the undersigned attorney. The Commissioner is authorized to charge any necessary fees, or credit any overpayment to Deposit Account 50-2401.

Respectfully submitted,

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